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10/733,347	12/12/2003	John David Kalina	14547	7463

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EXAMINER

THANH, QUANG D

ART UNIT PAPER NUMBER

3764

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,347	<b>Applicant(s)</b> KALINA ET AL.	
	<b>Examiner</b> Quang D. Thanh	<b>Art Unit</b> 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,7 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species IV, figs. 5, 5a and 6, including claims 1, 2, 4, 6, 8-20 and 22 in the reply filed on 7/10/2006 is acknowledged. The traversal is on the ground that "the various species identified by the Examiner are all directed thoracic spine positioning in a patient. As such, a search a pad or device for therapeutic correction of relating to such a pad without imposing a serious burden on the Examiner". This is not found persuasive because the search required for the diverse species is not entirely coextensive; and inasmuch as the diverse species differ in structure and operation, the patentability of each would likely turn on different grounds. Consequently, the search and examination of the entire application could not be made without serious burden on the Office. Applicants have not admitted that the diverse species are obvious variants; and inasmuch as the species are patentably distinct, the election requirement is proper. If the applicants believe that the species are obvious variants of each other they should state so on the record.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3, 5, 7 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "pad affixed to a

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**board**" (claim 13), "attachment means" (claim 14), "straps" (claim 15), "an adhesive" (claim 16), "mechanical fastener is Velcro" (claims 17-18) must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claim 4 is objected to because of the following informalities: "the top end and the bottom end" lacks antecedent basis. The phrase "**a** point from the bottom end where the tapering stops" should be replaced with -- **the** point from the bottom end where the tapering stops -- Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 13, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkins (4,572,578). Perkins discloses a pad (or upper thoracic portion) 15 (fig. 2-3) for therapeutic correction of thoracic spine positioning in a patient, said pad having a length, a width and a thickness (figs. 2-3), said length said pad being substantially the length of an upper thoracic spine of said patient; said width of said pad being substantially the width of vertebrae of the upper thoracic spine said patient (fig. 2, col. 1, lines 55-66); and said thickness of said pad being sufficient to induce a mild hyper-extension (fig. 3) of the upper thoracic spine of the patient when pad is positioned between the upper thoracic spine of the patient and a substantially hard surface (rigid frame member 11, fig. 1a-b), and the upper thoracic spine of the patient is pressed against said pad; wherein an upper surface of the pad which lies adjacent the upper thoracic spine in use, has a side-view profile shaped to accommodate a contour of the

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patient's spine as it evolves from a top end of the upper thoracic spine toward a bottom end of the upper thoracic spine (best seen in fig. 3); wherein the pad is affixed to a board 11 (fig. 2).

7. Claims 1-2 and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Porterfield (US 2003/0159698 A1). Porterfield discloses a pad having an upper thoracic portion (fig. 4) for therapeutic correction of thoracic spine positioning in a patient, said pad having a length, a width and a thickness (fig. 4), said length said pad being substantially the length of an upper thoracic spine of said patient; said width of said pad being substantially the width of vertebrae of the upper thoracic spine said patient (fig. 4); and said thickness of said pad being sufficient to induce a mild hyper-extension (fig. 5b) of the upper thoracic spine of the patient when pad is positioned between the upper thoracic spine of the patient and a substantially hard surface (floor in fig. 5b or seat frame 50/52 in fig. 9a), and the upper thoracic spine of the patient is pressed against said pad; wherein an upper surface of the pad which lies adjacent the upper thoracic spine in use, has a side-view profile shaped to accommodate a contour of the patient's spine as it evolves from a top end of the upper thoracic spine toward a bottom end of the upper thoracic spine (best seen in fig. 5b); wherein the pad is affixed to a board 50 (fig. 9b); attachment means 34 for attaching the pad; wherein the attachment means are straps 34 attached to the pad (fig. 12b); wherein the attachment means is an adhesive, a mechanical fastener Velcro 36 (fig. 12b, paragraph 52).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 9-10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porterfield in view of Pedrow (5,033,137). Porterfield discloses the claimed invention including an internal cavity 24 for receiving a gel filled core 22 (fig. 13), except it is silent regarding the gel being able to provide heat or cool effects. However, Pedrow teaches a similar orthopedic pillow comprising an internal cavity 66 for receiving a temperature maintaining element 68 (fig. 11). Pedrow further teaches that element 68 is preferably the type of gel filled pouch that may be either heated or cooled (col. 5, lines 14-35) to retain its temperature altered state for a period of time. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device in the Porterfield's reference, to include a temperature maintaining element such that it can be either heated or cooled, as suggested and taught by Pedrow, for the purpose of providing additional heating or cooling therapeutic effects.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porterfield in view of Meyer (5,105,489). Porterfield discloses the claimed invention except it is silent regarding the pad being formed of closed cell polyethylene foam.

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However, Meyer teaches a similar device 10 made of a closed cell polyethylene foam (col. 3, lines 15-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device in the Porterfield's reference, to select the closed cell polyethylene foam, as suggested and taught by Meyer, for the purpose of providing the desired support while affording a comfortable degree of cushioning to the user (col. 3, lines 15-26).

11. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porterfield in view of Liang (5,429,585). Porterfield discloses the claimed invention except for a vibratory means and a magnetic insert. However, Liang teaches a multi-function cushion having a vibratory device 6 and magnets 31 (fig. 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device in the Porterfield's reference, to include a vibratory device and magnets, as suggested and taught by Liang, for the purpose of providing a vibratory massaging motion and magnetic stimulation to the user (col. 4, lines 1-7).

***Allowable Subject Matter***

12. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The Central FAX phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**QUANG D. THANH  
PRIMARY EXAMINER**